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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,535	09/12/2005	Kenji Mori	MUR-045-USA-PCT	1710
27955	7590	10/26/2007		
TOWNSEND & BANTA c/o PORTFOLIO IP PO BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER MANUEL, GEORGE C	
			ART UNIT	PAPER NUMBER
			3762	
			MAIL DATE	DELIVERY MODE
			10/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/517,535

Applicant(s)

MORI ET AL.

Examiner

George Manuel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/4/05</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAdams et al (US 6,731,987) in view of Sibalis (US 4,919,648).

McAdams et al disclose a substrate film comprising layer 4 and an outward flange comprising layer 8, an electrode layer comprising layer 5. A deformed portion that causes the outward flange to project so as to surround the recess of the outward flange does not appear.

Sibalis discloses a deformed portion of a substrate film comprising cover 12. Cover 12 encloses all of the layers of applicator 10 and comprises a flexible conductive plastic material such as a polymer impregnated with carbon or surface metalized plastic.

One of ordinary skill in the art would have found it obvious to form layer 4 and layer 8 as a deformed substrate film having the deformed shape as disclosed in Sibalis

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because McAdams et al teach layer 4 is flexible to allow a close application of the electrode to the patient's skin. This is a similar feature for the cover 12 of Sibalis.

Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAdams et al (US 6,731,987) in view of Sibalis (US 4,919,648) and further in view of Phipps et al (US 5,125,894).

McAdams et al in view of Sibalis show all of the claimed features except for a recess for containing gel. The portion in Fig. 1 of McAdams et al between layer 8, does show somewhat of a recess for gel 3; however, Phipps et al more clearly define a recess in Fig. 3 that has a gel matrix 141 for holding the gel within the recess.

One of ordinary skill in the art would have found it obvious to modify the gel 3 of McAdams et al to comprise a gel matrix within a deformed portion as taught by Sibalis because the gel matrix teaching applies to a skin surface attachment structure similar to the structures disclosed in McAdames et al and Sibalis.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.

/George Manuel/  
George Manuel  
Primary Examiner  
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